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Case No.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1983

PROFESSIONAL POSITIONERS, INC.

A WISCONSIN CORPORATION

PROFESSIONAL POSITIONERS, INC.

A DELAWARE CORPORATION

GERALD W. HUGE

RICHARD W. ALLESEE

PETITIONERS-DEFENDANTS,

VS.

T.P. LABORATORIES, INC.

AN INDIANA CORPORATION

RESPONDENT-PLAINTIFF.

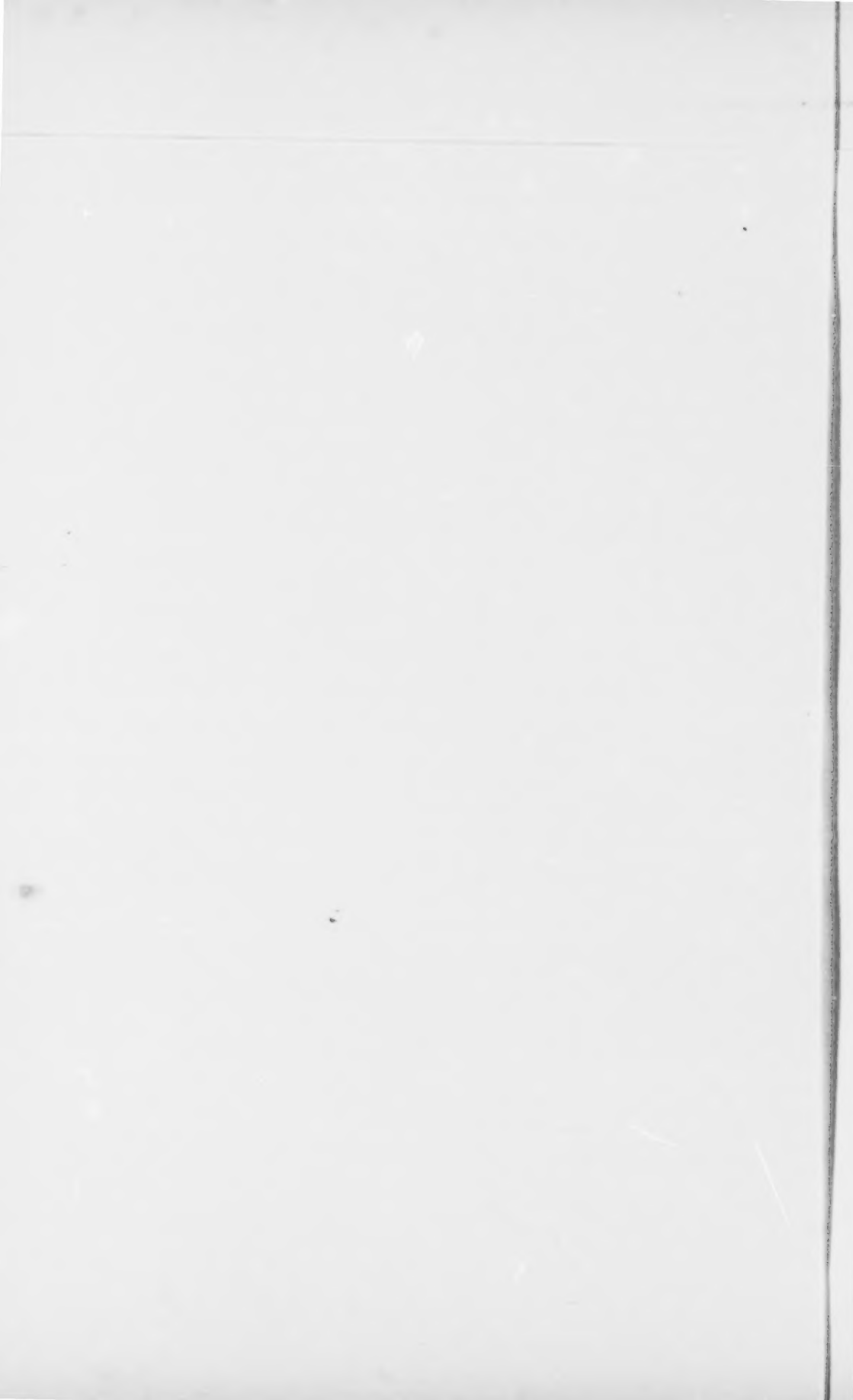
ON APPEAL FROM
THE COURT OF
APPEALS FOR
THE FEDERAL
CIRCUIT APPEAL
83-660 CROSS
APPEAL 83-680

PETITION FOR WRIT OF CERTIORARI

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414-271-1318
414-278-7733

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44 pp



I. QUESTIONS FOR REVIEW

1. Should the patentee be freed of the burden of proving experimental use, where public use of an invention more than one year before the patent application has been proven? Did the Court of Appeals for the Federal Circuit properly change the long standing law on burden of proof to put the burden on defendants to dis-prove such experiment?
2. Was it proper for the Court of Appeals for the Federal Circuit to implicitly adopt a view of the facts contrary to that of the District Court without applying the standards of 52(a) FRCP, and without any opportunity to hear the personal testimony



of the inventor and others? Should it have remanded the case instead?

3. Does the period of permitted experimental use which does not offend 35 U.S. Code § 102(b) though it is more than one year before a patent application end when the claimed invention is demonstrated to be workable? Does it end with an admitted reduction to practice?

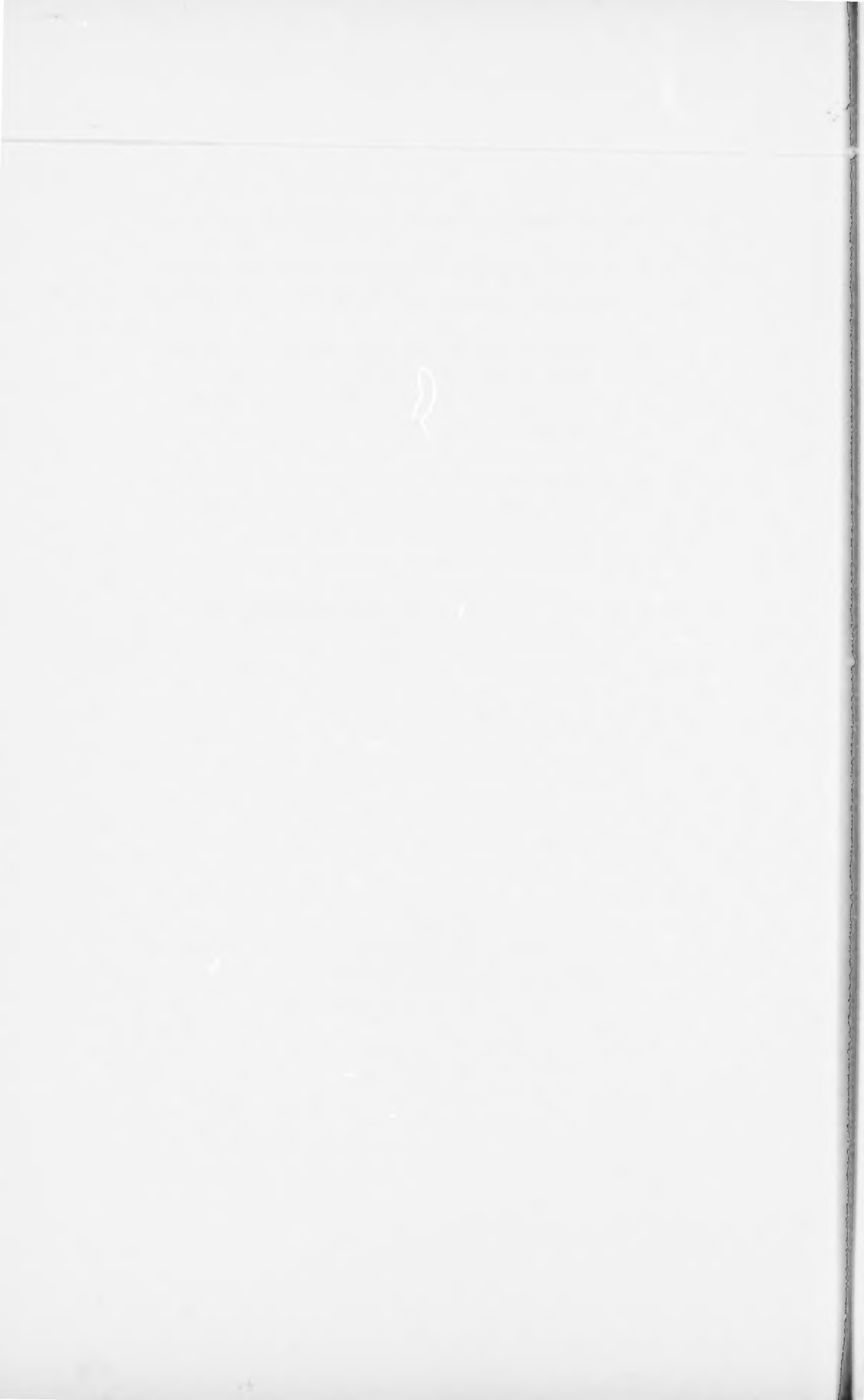
II. PARTIES

All parties are named in the case caption. Corporate defendant is a subsidiary of Bristol-Myers Company, a publicly held corporation of Delaware. Its subsidiaries are wholly owned.

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V. OPINIONS BELOW

The district court opinion is unreported but is found in the Appendix filed at the end of this Petition.

The Opinion of the Court of Appeals for the Federal Circuit is reported at 220 United States Patent Quarterly 577. It is not yet reported elsewhere. It is found in the Appendix hereto.

VI. JURISDICTION

The jurisdiction of the U.S. Supreme Court is based on 28 U.S. Code § 210(c) and 28 U.S. Code § 1254. The date of the decision of the Court of Appeals for the Federal Circuit was January 4, 1984.

VII. STATUTES

35 U.S. Code § 102(b). Conditions for patentability; novelty and loss of right to patent



A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

35 U.S. Code § 282(2). Presumption of validity; defenses

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability.

VIII. STATEMENT OF THE CASE

A. Jurisdiction

Jurisdiction of the federal courts is based on 35 U.S. Code § 281; 28 U.S. Code § 1331; and 28 U.S. Code § 1295.

B. Decision of District Court

The district court held that defendants had the burden of proving by clear and convincing evidence that public use of the patented invention had occurred more than one year before the patent application for the patent in suit was filed. It found that such use was clearly established and that the users were not under any obligation of secrecy to the inventor. It found no contrary evidence.

Having so found, it placed the burden of proving any exception to take the uses out of the category of public uses prohibited by 35 U.S. Code 102(b) upon the patentee (plaintiff). The agreed facts submitted before trial included plaintiff's statement that reduction to practice occurred in 1956. The evidence in the case was analyzed by the court, including the testimony and conduct of the inventor (now deceased) and the court held



that there was not experimental use as to at least the last two proven uses earlier than the statutory bar date.

C. Decision of the Court of Appeals
for the Federal Circuit

The Court of Appeals held that the District Court had incorrectly placed the burden of proof of experimental use on plaintiff (patentee). In so doing it upset settled law on the point as discussed below.

It then reversed the judgment of the District Court on invalidity, and held the prior uses experimental without remand to the trier of facts and without full analysis of the findings and record under Rule 52(a) FRCP. It gave no effect to plaintiff's admitted reduction to practice of the invention in 1956 before any of the proven public uses.



IX. ARGUMENT

A. The Burden of Proof Was Decided Contrary to Settled Law.

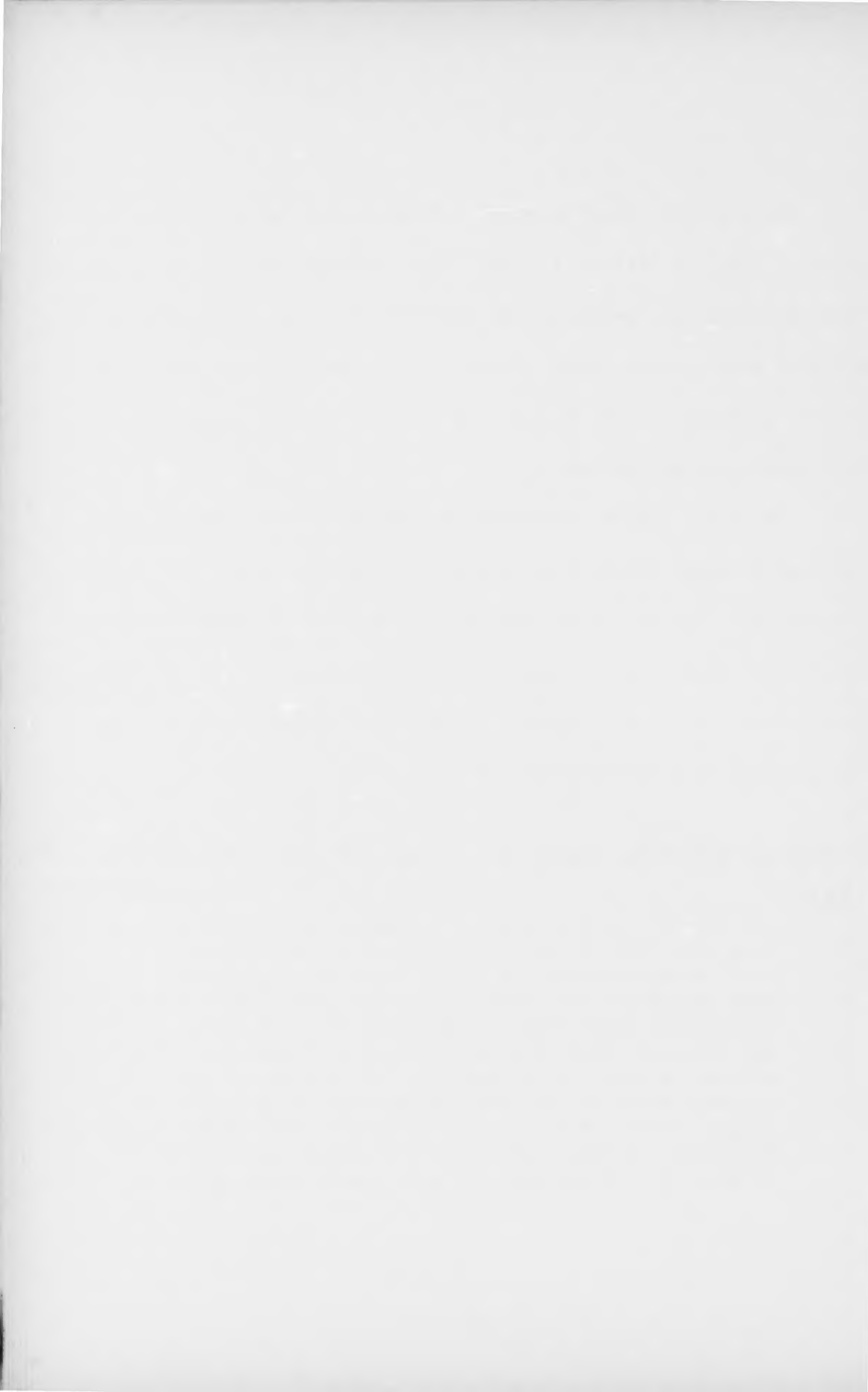
The Court of Appeals has held that defendant is responsible not only for proving that there was a public use, but that it was not within any exception to 35 U.S.C. § 102(b). The structure of the statute does not support such a reading. Despite the fact that the statute was completely rewritten in 1952 to codify the patent law, there is not one word in the statute concerning the experimental use exception. The statutory condition is that if public use has occurred more than a year before the filing of a patent application, that patent application is barred. There are a great many cases that lay a heavy burden on a defendant to prove that such a use has occurred before a patent will be invalidated for this reason. There is also a long line of cases holding that if even one such use is proven, the patent cannot survive.

Most of the cases also hold that once a public use is established, the burden of proof or the burden of persuasion shifts to the inventor to allege and prove that there is an exception to the rule stated in 35 U.S.C. § 102(b) which applies to the particular patent.

It has been thought to be settled law in the United States that the burden of proof was on the inventor to establish by clear and convincing evidence that the occurrence should not be a bar because, for instance, it was an experiment. The following are illustrative:

Stewart-Warner Corp v. City of Pontiac, Mich.,
717 F.2d 269, 219 U.S.P.Q. 1162 at 1165 (CA-6,
1983):

In this Circuit, a party challenging the validity of a patent based on the statutory bar of 102(b) carries the burden of making a prima facie showing that the invention was on sale by clear and convincing evidence. Once such a showing is made, the burden shifts to the patentee to prove that the device was not on sale because it was not functionally operative, or because it was used only for



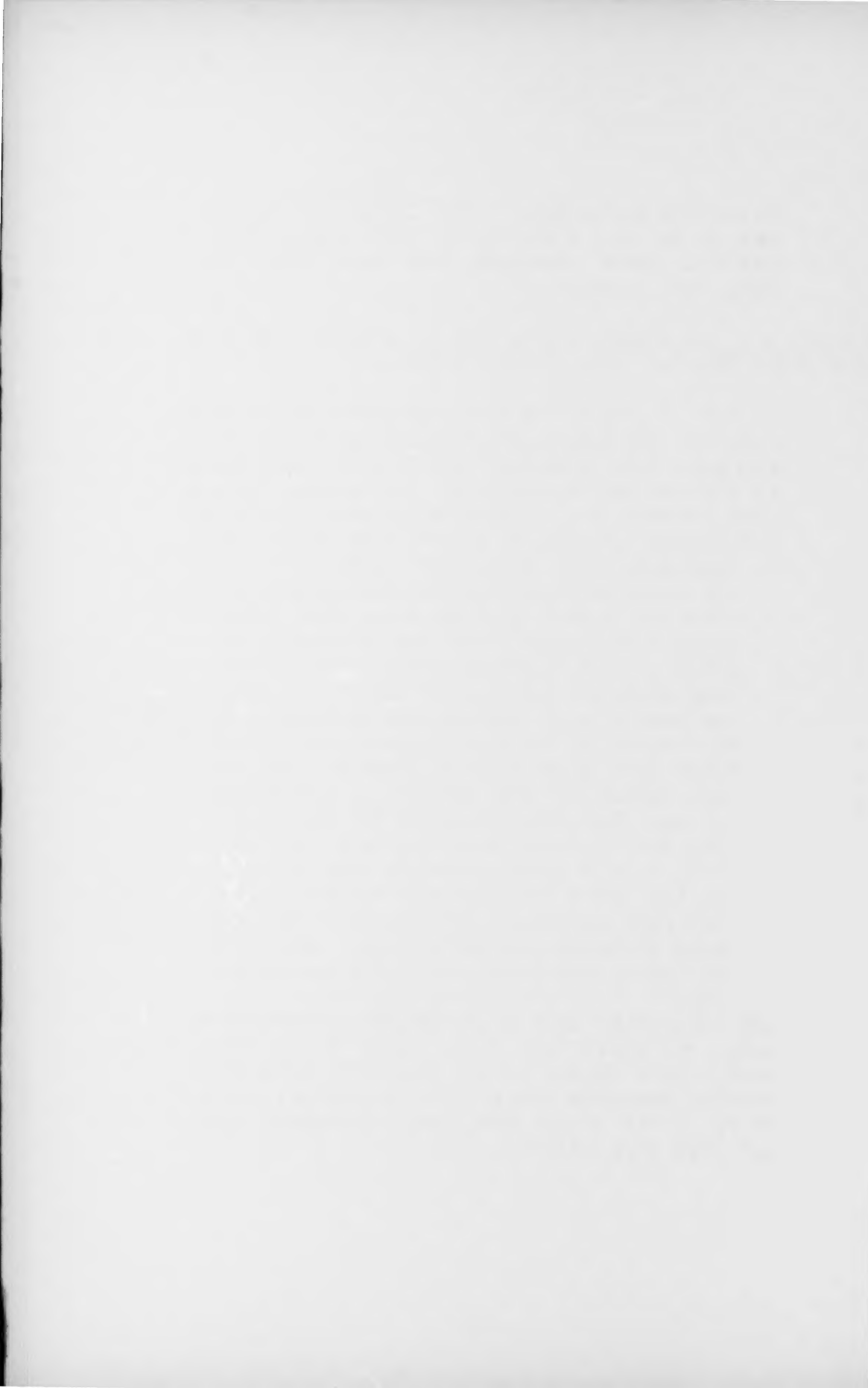
testing purposes. *FMC Corp. v. Myers*, 384 F.2d 4, 155 USPQ 299 (6th Cir. 1967), cert. denied, 390 U.S. 988, 157 USPQ 720 (1968).

Kock v. Quaker Oats Co., 681 F.2d 649, 215 U.S.P.Q. 200 at 204 (CA-9, 1982):

To insure that abuses section (102(b) is designed to prevent do not arise, the burden of proof that sale is for an experimental purpose is on the inventor. The Supreme Court so indicated in *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249 (1887):

In considering the evidence as to the alleged prior use for more than two years of an invention which, if established, will have the effect of invalidating the patent, and where the defense is met only by the allegation that the use was not a public use in the sense of the statute, because it was for the purpose of perfecting an incomplete invention by tests and experiments, the proof, on the part of the patentee, the period covered by the use having been clearly established, should be full, unequivocal, and convincing.

Id. at 264; see also *Omark Industries, Inc. v. Carlton Co.*, 652 F.2d 783, 787, 212 USPQ 413, 416-417 (9th Cir. 1980); *Aerovox Corp. v. Polymet Mfg. Corp.*, 67 F.2d 860, 861, 20 USPQ 119, 120 (2d Cir. 1933).



Norfin v. IBM, 625 F.2d 357, 207 U.S.P.Q. 737 at 739:

. . . In McCullough Tool Company v. Well Surveys, Inc., 343 F.2d 381, 145 USPQ 6 (10th Cir. 1965), cert. denied, 383 U.S. 933 (1966), 148 USPQ 772 we observed:

. . . The burden is upon the one asserting prior public use to establish it by clear, cogent and satisfactory proof to remove all reasonable doubt thereof; but when a use is shown that has occurred prior to the statutory period, it is incumbent upon the patentee to show that such use was experimental only. [Citations]. The issue of whether a use of the device is experimental or public is one of fact. [Citations]. And, the trial court's finding in this respect is binding upon the Court of Appeals unless it is clearly erroneous.

DeLong Corp. v. Raymond International Inc., 622 F.2d 1135, 206 U.S.P.Q. 97 at 104 (CA-3, 1980):

. . . When, however, the inventor has chosen to sell his invention more than one year prior to the date of the patent application the presumption is, in the absence of evidence to the contrary, that the experimental period is over and that the invention is suitable for commercial exploitation. The burden of proof then shifts to the inventor, for as the court stated in

Koehring Co. v. National Automatic Tool Co., 362 F.2d 100, 104, 149 USPQ 887, at 890-891 (7th Cir. 1966), "once a single use of an operative device embodying the invention prior to the critical date has been shown the inventor must carry the burden of proving that the use was part of a bona fide program of experimentation."

Paeco, Inc. v. Applied Moldings, Inc. et al., 562 F.2d 870, 194 U.S.P.Q. 353 at 357 (CA-3, 1977):

In the case sub judice, the district court found that Paeco had failed to meet its burden of showing by clear and convincing evidence that the public sale of the Colony beam prior to the critical date was experimental in nature, motivated by a desire to perfect or improve the invention. We may disturb this finding of fact by the district court only if clearly erroneous. However, we find no clear error here.

Red Cross Mfg. Corp. v. Toro Sales Co., 525 F.2d 1135, 188 U.S.P.Q. 241 at 244 (CA-7, 1975).

The policy underlying the "on sale" bar is to prevent an inventor from holding back the secrets of his invention from general public knowledge while at the same time exploiting it commercially, thereby extending the duration of his legal monopoly. Koehring Co. v. National Automatic Tool Co., 362 F.2d 516, 520 68 USPQ 54, 58 (2nd Cir. 1946); see generally,

New Guidelines for Applying the On Sale Bar to Patentability, 24 Stan. L. Rev. 730, 733-34 (1972). Under the statute, an existing patent is presumed to be valid. 35 U.S.C. § 282. When the objection is asserted, the burden of establishing that the patented product was "on sale" before the critical date is on the objector. *Dart Industries, Inc. v. E.I. Dupont de Nemours and Co.*, 489 F.2d 1359, 1364, 179 USPQ 392, 395-396 (7th Cir. 1973), cert. denied, 417 U.S. 933, 179 USPQ 392. This burden must be satisfied by clear and convincing evidence. *Minnesota Mining & Mfg. Co. v. Kent Industries, Inc.*, 409 F.2d 99, 100, 161 USPQ 321, 322 (6th Cir. 1969). Once such activity has been successfully established, invalidity may be avoided by showing that the sales activity was "substantially for purposes of experiment." *Smith and Griggs Mfg. Co. v. Sprague*, 123 U.S. 249, 256 (1887). The burden of proving experimental purpose rests with the inventor and must be met with "full, unequivocal, and convincing evidence. *Id.* at 264.

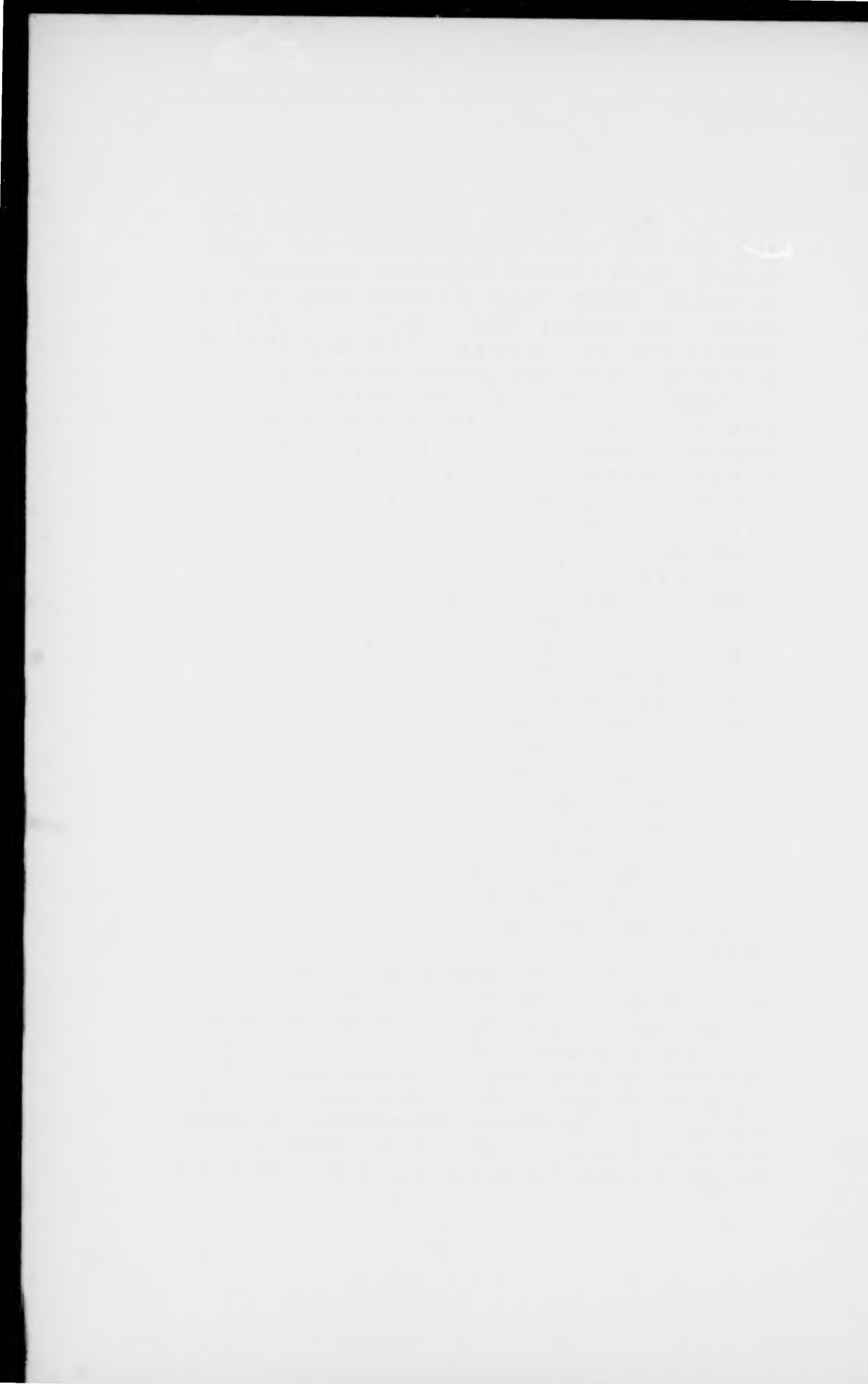
Dart Industries v. E.I. du Pont de Nemours & Co., 489 F.2d 1359, 179 U.S.P.Q. 392 at 396 (CA-7, 1973):

We first note that § 102(b) contains several distinct bars to patentability, each of which relates to activity or disclosure more than one year prior to the date of the applica-

tion. Two of these--the "public use" and the "on sale" objections--are sometimes considered together although it is quite clear that either may apply when the other does not. If either objection is raised, the burden of proving that the patented product was in "public use" or "on sale" before the critical date is on the objector. However, once such activity has been established, the burden of avoiding the statutory bar by proving a purely experimental purpose rests upon the inventor. . . .

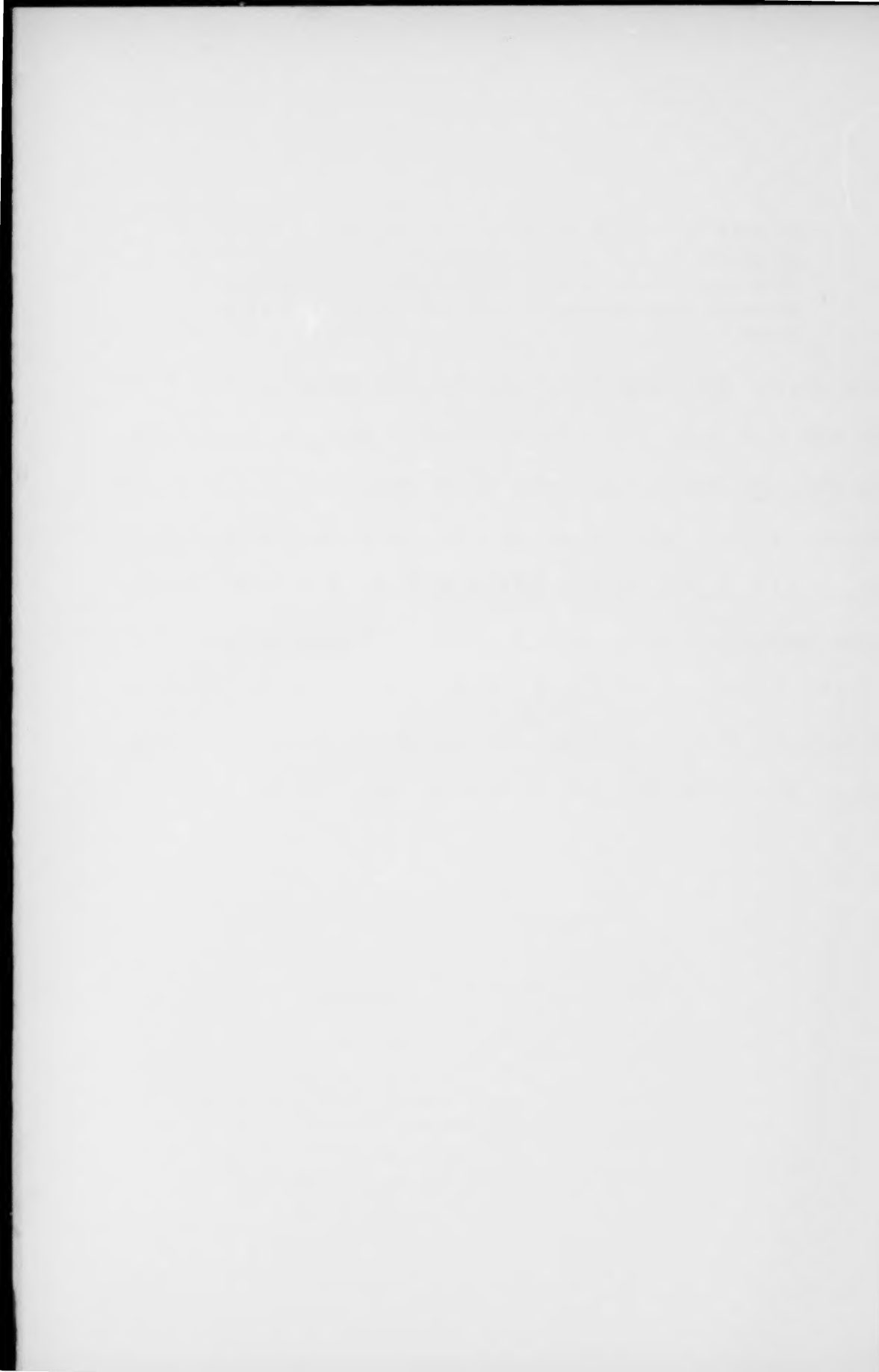
Plaintiff's argument that the product could not have been "on sale" because it had not yet been completed must also be rejected. In cases in which a sale has been made before the critical date, a typical issue is whether the product sold is sufficiently similar to the product described in the claims to invoke the statutory bar. See, e.g., *Frantz Mfg. Co. v. Phenix Mfg. Co.*, 457 F.2d 341, 318-323, 173 USPQ 266, 269-273 (7th Cir. 1972). Exact identity is not required as long as the invention is essentially completed at the time of the invalidating sale.

In this case, the product which was sold underwent no significant change after the disqualifying sales occurred. It had already been sufficiently reduced to practice to avoid the reference dated April 25, 1951; and it subsequently achieved commercial success in the form in which it was sold. More significantly, even though



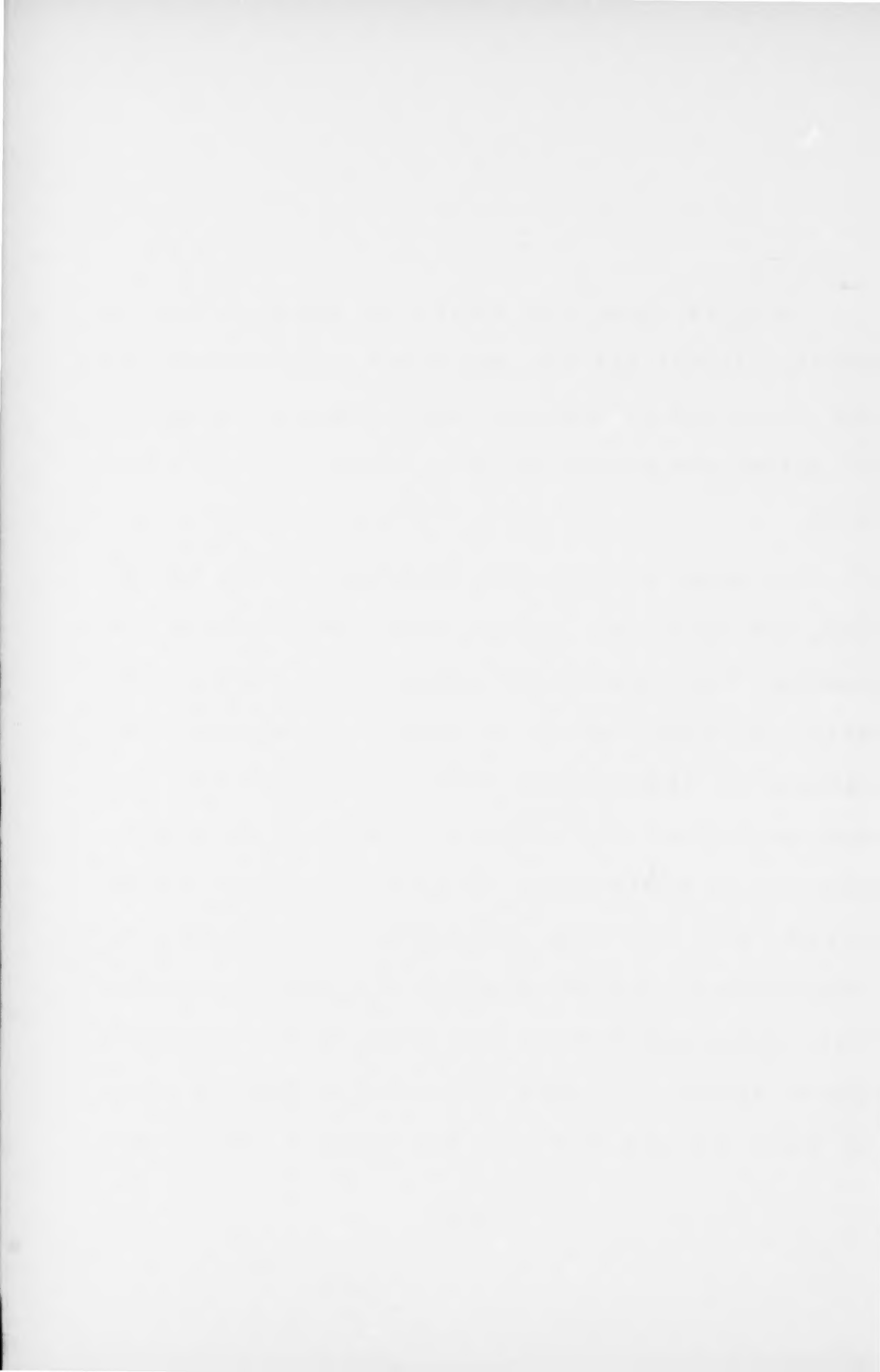
Bradt's laboratory tests could not guarantee ultimate commercial acceptance, they were sufficient to demonstrate the workability of his conception.

See also Scharmer v. Carrollton et al., 525 F.2d 95, 187 U.S.P.Q. 736 (CA-6, 1975); Dunlop Co. Ltd. v. Kelsey-Hayes Co., 484 F.2d 407, 179 U.S.P.Q.129 (CA-6, 1973); Strong et al. v. General Electric Co., 434 F.2d 1042, 168 U.S.P.Q. 8 (CA-5, 1971); Ajem Laboratories, Inc. v. Centri-Spray Corp., 424 F.2d 1124, 165 U.S.P.Q. 737 (CA-6, 1970); Minnesota Mining & Mfg. Co. v. Kent Industries, Inc., 409 F.2d 99, 161 U.S.P.Q. 321 (CA-6, 1969).



In this case the Court of Appeals for the Federal Circuit has not resolved a conflict, it has reversed a long-standing current of authority and placed the burden of proof where it ought not to be.

The cases dealing with experimental use establish, among other things, that the intent of the inventor, the presence or absence of commercial activity, the presence or absence of secrecy, the presence or absence of records concerning the experimentation, the presence or absence of experimentation on variations of the structure being tested, and the like, are all indicia relevant to a determination of whether there has been bona fide experimentation concerning the claimed subject matter (not some orthodontic device that has been in use for many use prior to the inven-

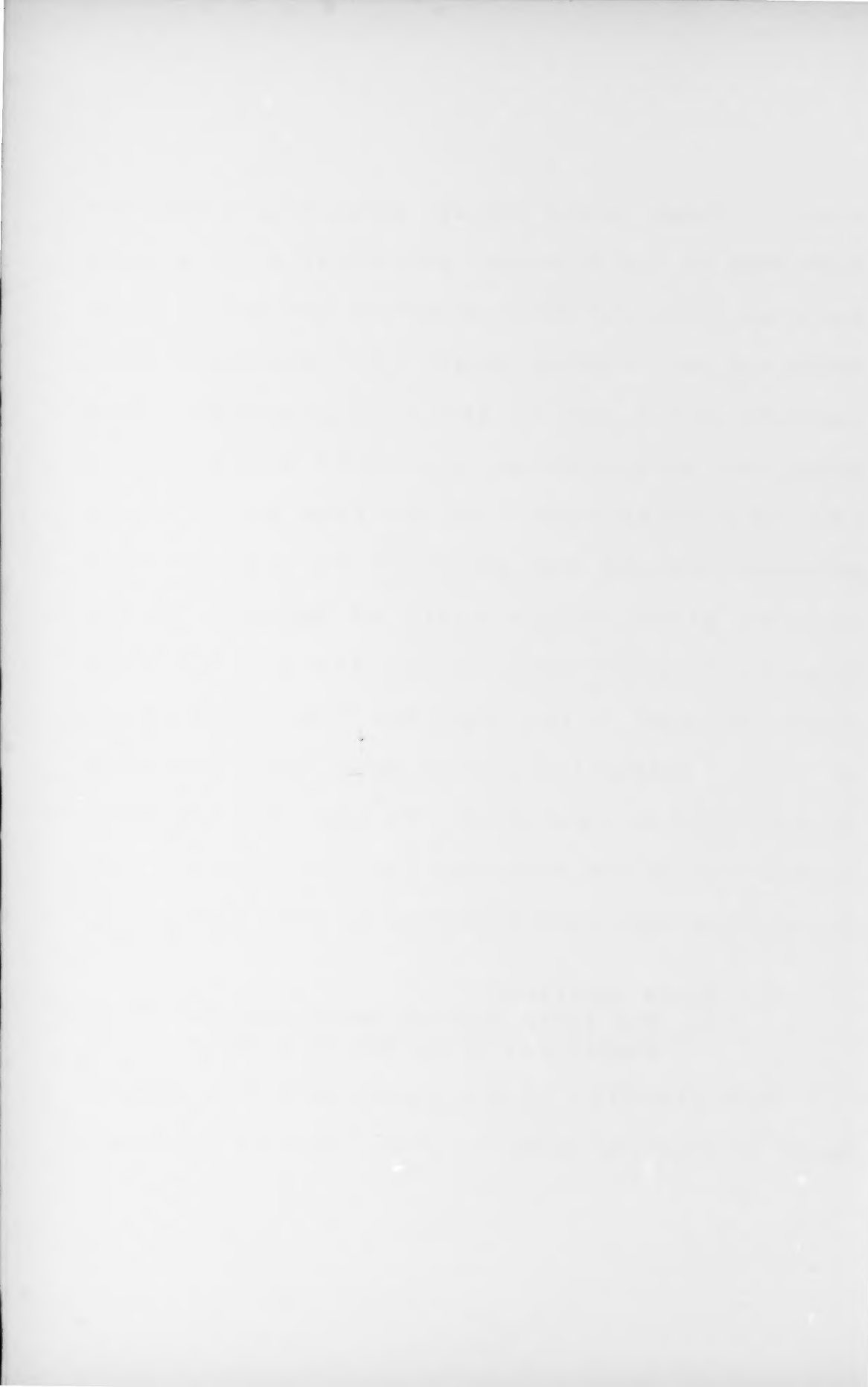


tion). These things are all peculiarly within the knowledge of the inventor, particularly in a case such as this one where defendant has had to fight tooth and nail even to obtain the knowledge that records exist and to get them produced. Even after they were produced, plaintiff would change its testimony from time to time as to which patients received the patented structure. The figures given in the Court of Appeals for the Federal Circuit opinion are derived not from rigorous proof in the case, but from a compilation of unknown authenticity as to which there has been no definitive testimony. We know that the three cases prior to the statutory bar date exist. We do not know what others existed at that time.

B. Facts Amplified

1. The facts support petitioner ,
regardless of burden of proof.

The District Court found as a fact that by April of 1959 the inventor, Dr. Harold Kesling,



knew that the claimed "precision seating springs" of Figure 7 of the patent operated as designed. This was confirmed when he treated Susan Spiers and Sheila Rumely. It found that the record card DX 277 indicated favorable results as early as February 1960. (District Court Decision Appendix page 21).

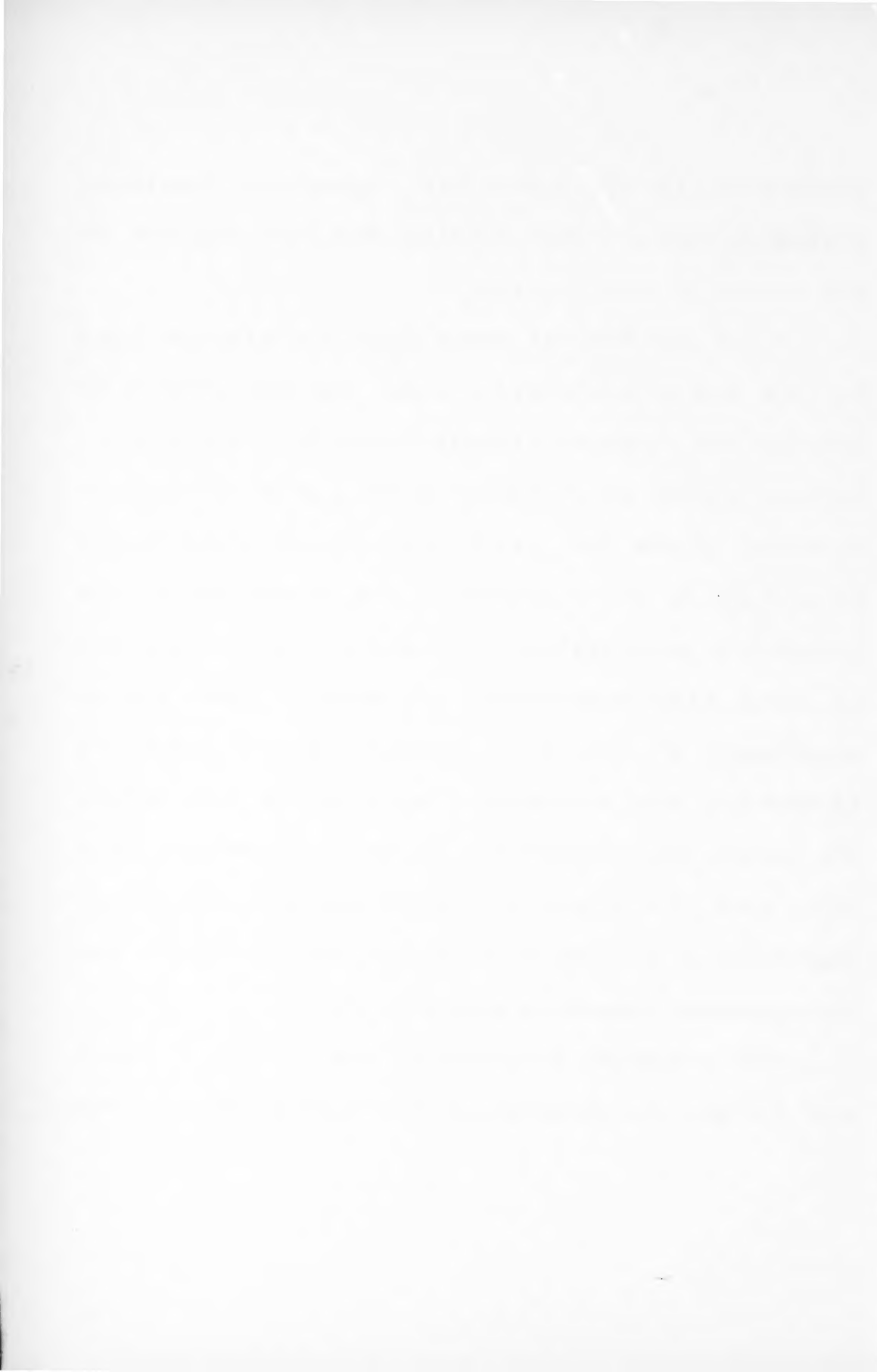
The inventor himself testified that there was no change in the device for the purpose of experiment or otherwise, from the time he began treating Nancy Furst until the time the patent application was filed disclosing the same device in Figure 7 (Appendix page 21).

The District Court held that the delay was unreasonable because the device proved satisfactory immediately. (Appendix page 21-22) At that point his time began to run under 35 U.S.C. § 102(b). The court held that when an experiment tolls § 102(b) the one year period of limitation

commences to run when the invention disclosed proves workable. That holding did not depend on the burden of proof issue.

There are several basic fact determinations by the District Court, which had the benefit of hearing the inventor himself testify, (an opportunity which will never come again since the inventor is now deceased) and which also heard testimony by other orthodontists in and out of the inventor's partnership. It held: (1) there was no bona fide experiment, (2) even if there was an experiment it led to a determination that the invention was successful well over a year before the patent application was filed. (Appendix page 22), and (3) plaintiff's delay without either improving or filing his patent application was unreasonable (Appendix pages 20-22).

The procedure followed by the District Court was first, to determine whether a use that was



public in fact occurred and second, to determine whether such use was not a "public use" within 35 U.S.C. § 102(b) because it was experimental within the meaning of Elizabeth v. American Nicholson Pavement Co., 97 U.S. 126 (1877). (Appendix pages 16-17). This procedure is in accord with the ruling of the Court of Appeals for the Federal Circuit.

The District Court found that the burden of proof of public use is on the defendant in a patent infringement case. That also accords with the holdings of the Court of Appeals of the Federal Circuit. (Appendix page 18). The court then went on to hold (Appendix pages 18-19):

The evidence in this case clearly establishes use by at least three patients more than one year prior to the application date. Furthermore, these users were 'under no limitation, restriction or obligation of secrecy to the inventor.' . . . Certainly there is no evidence to the contrary and there is testimony to support such a finding. (DX 355 - deposition of Dr. B.L. Furst) Nancy Furst's father at

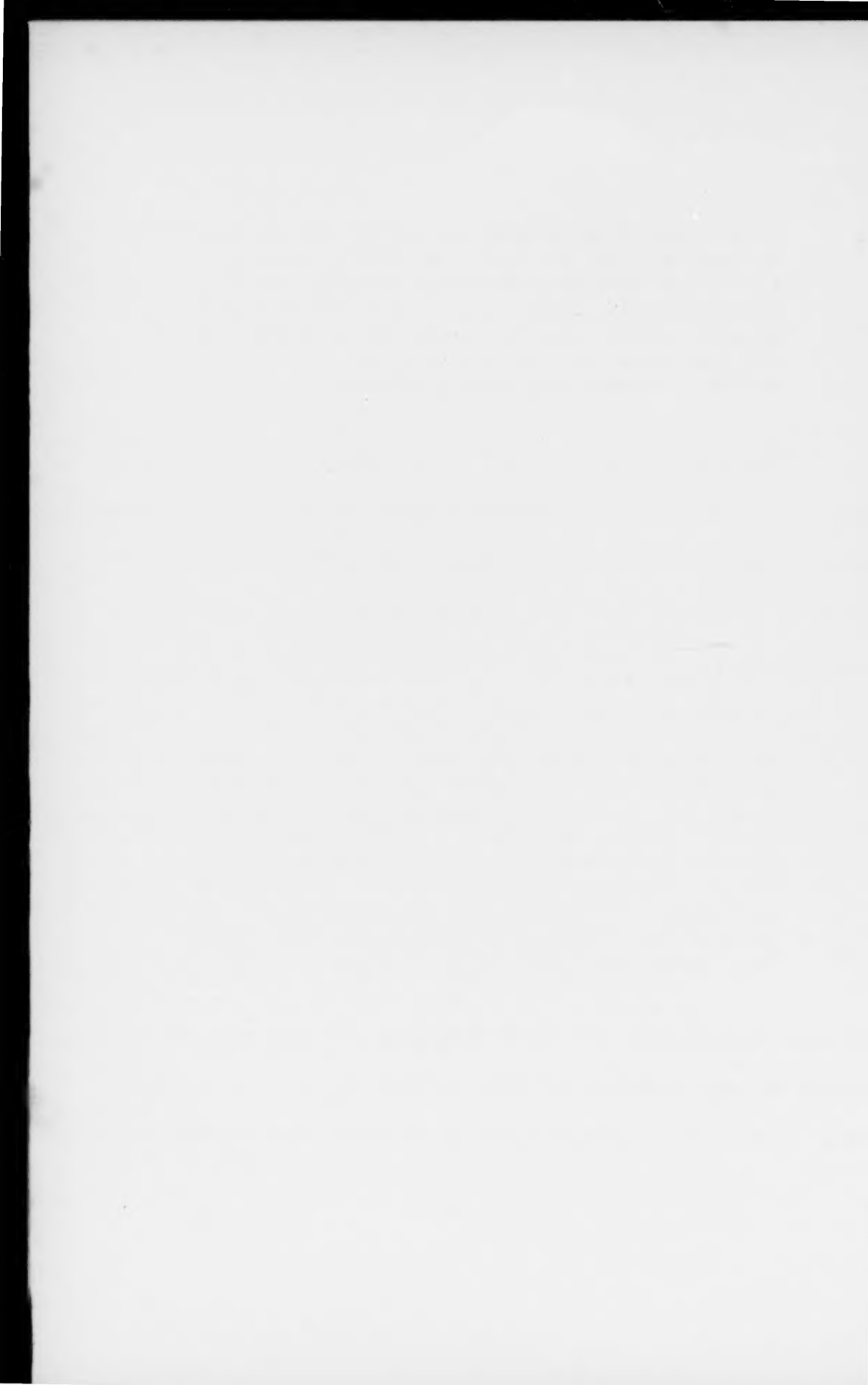
9); (DX 356 - deposition of Susan Spiers Elliot at 7); (DX 357 - deposition of Sheila Rumely Brady at 7). Consequently, the court can only conclude that the patients were under no obligations of secrecy, or for that matter, under any restrictions.

The court also had the opportunity to hear the inventor himself testify that he did not place these patients or their families under any obligations of secrecy nor under any obligation of reporting as to how the invention worked.

The court further held:

The plain fact is that the claimed invention was not kept secret. It was open to public observation without restriction which is sufficient to constitute public use. (Appendix page 19). Consequently, the feigned secrecy relied upon by TP accords it no aid in claiming that the 'use' was not 'public.'

These holdings do not depend in any way on the court's application of the burden of proof and in any case, the court indicated that the burden was



on the defendant when it made these holdings. The court then went on to analyze the experimental use exception. It did hold at that point that the inventor bears a heavy burden of showing that the public use was bona fide experimentation. (Appendix page 20). (citing cases). It further held that an inventor is only permitted a reasonable period of experimentation. It then went on to hold the experimental use exception unavailable to plaintiff TP. Its findings of fact on that branch of the case were as follows

(Appendix page 20-21)

First, the evidence presented does not establish that the patentee was conducting a bona fide experiment. On the contrary, the record shows that the uses were random and poorly monitored. The only records kept by Dr. H. Kesling were the patient records. Dr. H. Kesling, the inventor, did not always evaluate how well the precision seating springs worked when the patients visited the clinic. Other doctors often made evaluations of performance. Furthermore, while the issue of experimentation is in effect a matter of the inventor's



intent, in the present case the evidence indicates that his intent was not experimentation. In experimenting on a prior "invention," Dr. H. Kesling kept accurate records of the results of his experiments. In the present case, the records are scanty at best. (Tr. at 967). . . . the dearth of such records indicate that the use was not an experiment.

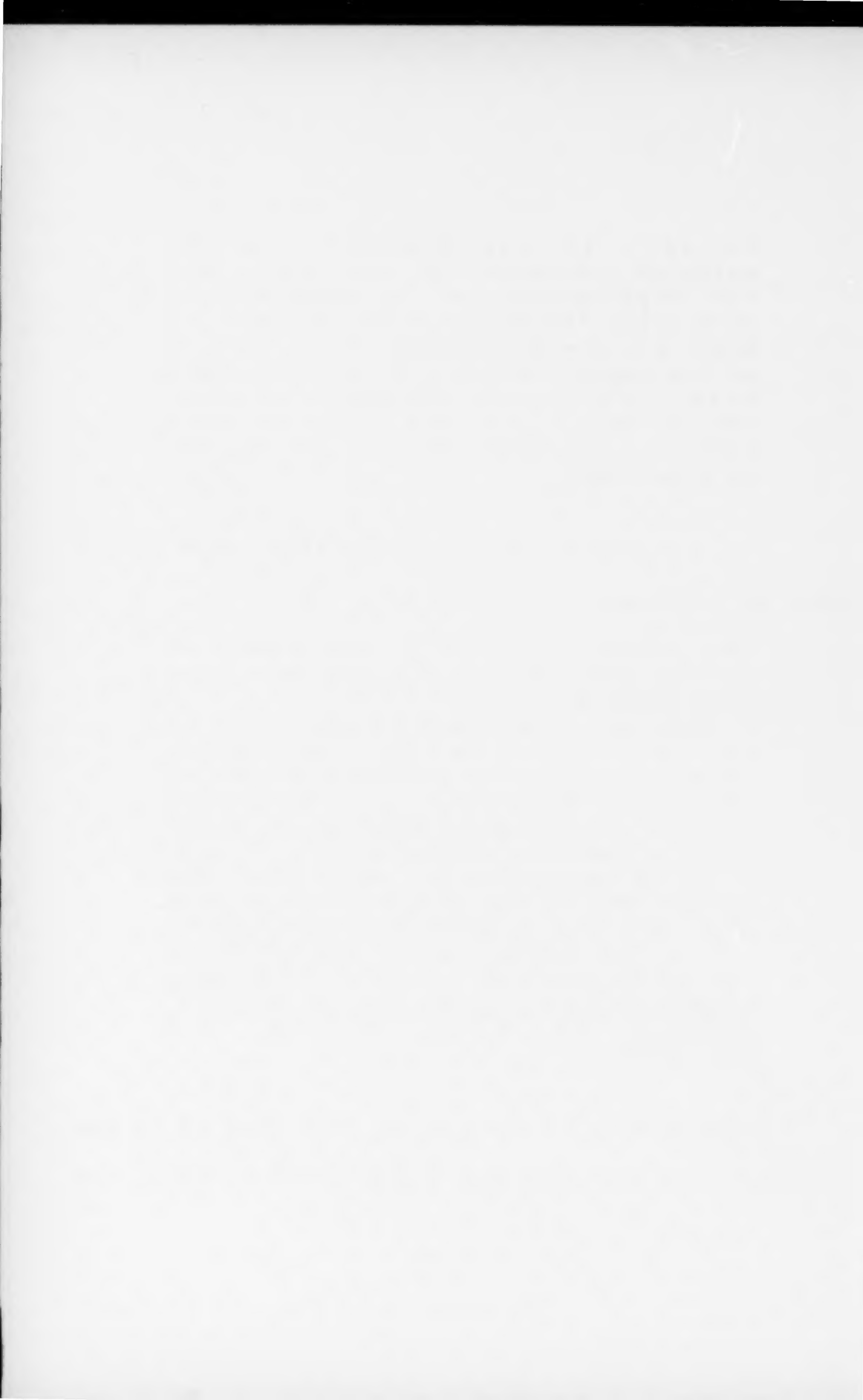
Its holdings of law (Appendix page 20-21) were as follows:

The inventor bears a heavy burden of showing that the public use was bona fide experimentation. . . .

The experimental exception is further limited in time. An inventor is only permitted a reasonable period of experimentation. . . . Whether or not the use was experimental is, however, a question of fact. . . .

It is important to note that the burden was on the plaintiff TP to show that use was a genuine experiment. . . . The experimental use exception 'is to be guarded closely.' Atlas Chemical Industries, Inc. v. Moraine Products, 184 U.S.P.Q. 281, 283 (6th Cir. 1974).

Separately it went on to hold that if it was assumed that the use was experimental that the



delay in filing the patent application was unreasonable. (Appendix page 21).

The court held on undisputed facts that the invention was used in August of 1958 and that by April of 1959 Dr. H. Kesling knew that the precision seating springs operated as designed, which was confirmed when he treated Susan Spiers and Sheila Rumely. The Spiers' positioner was placed in November of 1960 and the Rumely positioner was placed in November of 1959. The District Court held that the record card indicated favorable results as early as February of 1960.

Nevertheless, Dr. H. Kesling waited until February 19, 1962 to file his patent application. Significantly, the claimed invention disclosed in Figure 7 of the patent in suit is substantially the same as the precision seating spring disclosed in the positioner (DX 266) supplied to Nancy Furst in August of 1958. Finally, Dr. H. Kesling, the inventor, himself testified that the precision seating springs supplied to Furst, Spiers and Rumely were substantially the same as those disclosed in Figure 7 of the patent in suit. (Tr. at 1039-40).



The delay here was unreasonable because the device proved satisfactory immediately. At least early as 1960 Dr. Kesling learned that the invention was workable.

The court went on to make a finding of law:

At that point his time began to run under 35 U.S.C. § 102(b). . . . This Court is of the opinion that when an experiment tolls section 102(b), the one-year period of limitation commences to run when the invention disclosed proves workable. . . . The evidence indicates, however, that not even novel changes were made in the basic conception in public use in 1960.

Whether this Court finds the period of experimentation unreasonably long or that Dr. H. Kesling did not conduct a bona fide experiment, the public use, as found earlier, occurred more than one year prior to the filing date of the patent application. Under 35 U.S.C. § 102(b), this public use of the basic concept invalidates the patent in suit.

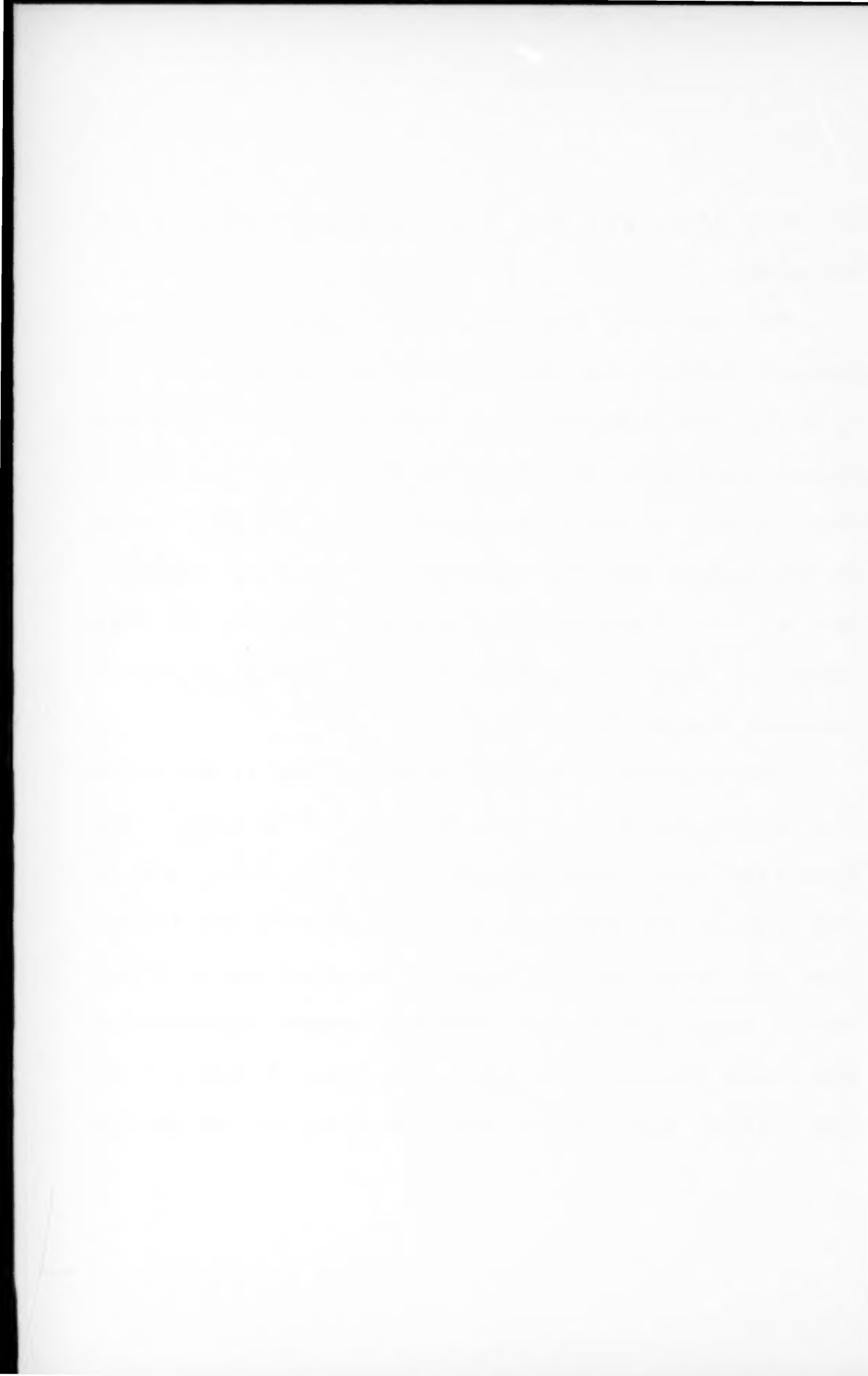
The Court specifically held at Appendix page 23 that all other issues of infringement and validity were made moot by these holdings and did not need to be decided. If the Court's decision is over-



turned they are not moot and will require a decision.

As held by the Court of Appeals for the Federal Circuit in the second paragraph of its opinion "TP admits that the inventor used the dental appliance on three orthodontal patients during the critical period." Thus the only issue on the appeal was the application of the experimental use doctrine, not the use itself. On that issue the Court of Appeals for the Federal Circuit reversed the District Court.

The grounds given for reversal had to do with the application of the burden of proof. The Appellate Court made no mention of the fact (which was one of the admitted facts preceding the trial) that the invention was reduced to practice in 1956. It is also undisputed that the patent application was filed February 19, 1962 and that Figure 7 of the patent application was identical to the device



made in 1956 and the devices tested in 1958 and following, concerning which TP asserts the experimental use exception.

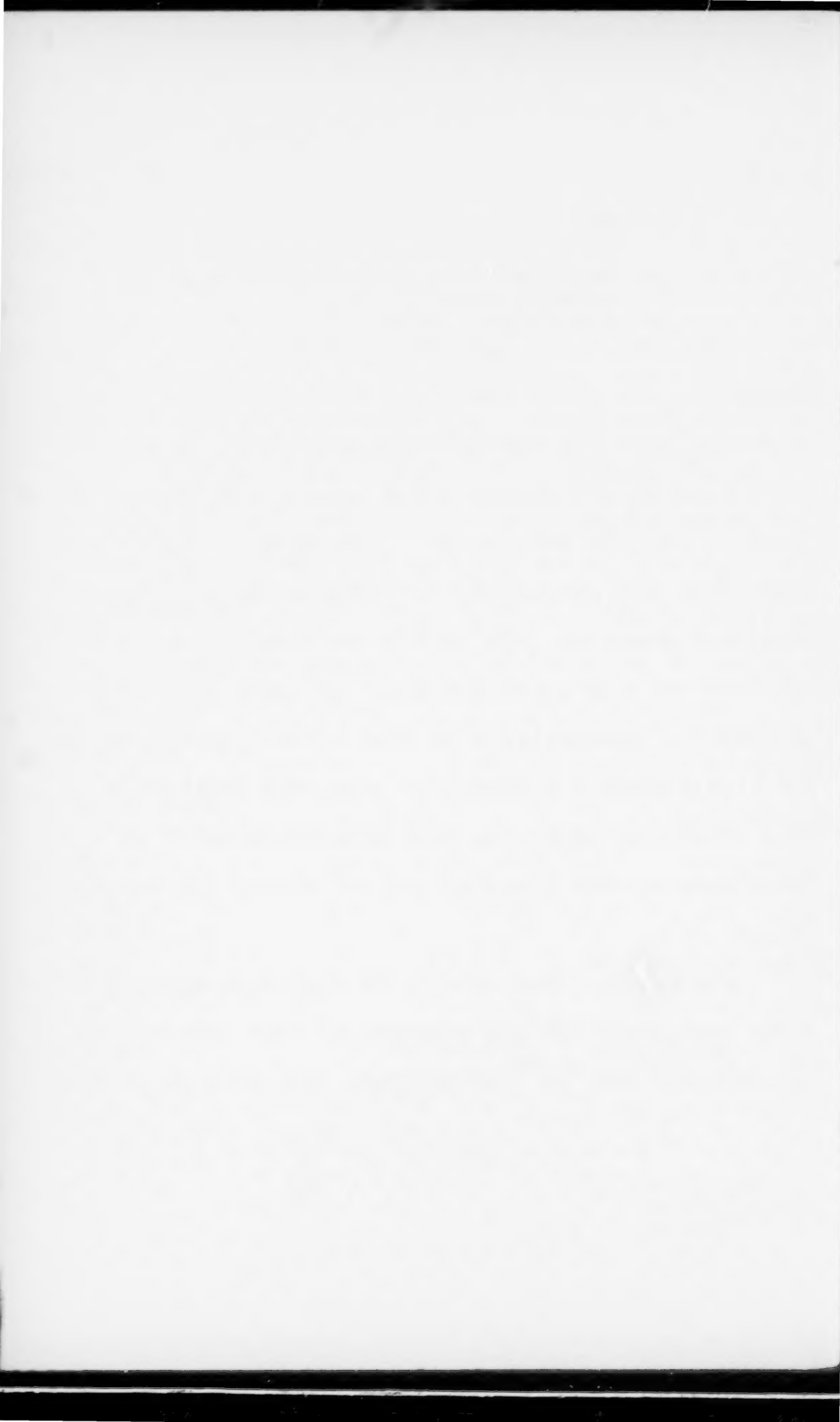
The public nature of the uses is not really in dispute. The only dispute is whether the experimental use doctrine referred to in Elizabeth v. Pavement Co., 97 U.S. 126, 24 L. Ed. 1000 (1877), and interpreted through the years in a multitude of other cases, does in fact apply to the fact situation found by the District Court, whether the burden of proof holding affects that determination, whether the holding as to burden of proof made by the Court of Appeals for the Federal Circuit was correct, and whether the Court of Appeals should have altered the fact findings or should have remanded to the trier of fact.



2. The Court of Appeals altered the fact findings of the District Court without due regard for Rule 52(a).

The Court of Appeals, rather than simply accepting the facts found by the District Court and applying the law to them, proceeded to analyze only some of the evidence for itself, beginning at page 4 of its decision. However, so far as the testimony was concerned, it had access only to the transcripts, not to the live testimony of the witnesses and particularly of the inventor himself. Its analysis of the patient-record cards is significantly different from the analysis of the District Court who did have the benefit of the testimony of the inventor and of other orthodontists.

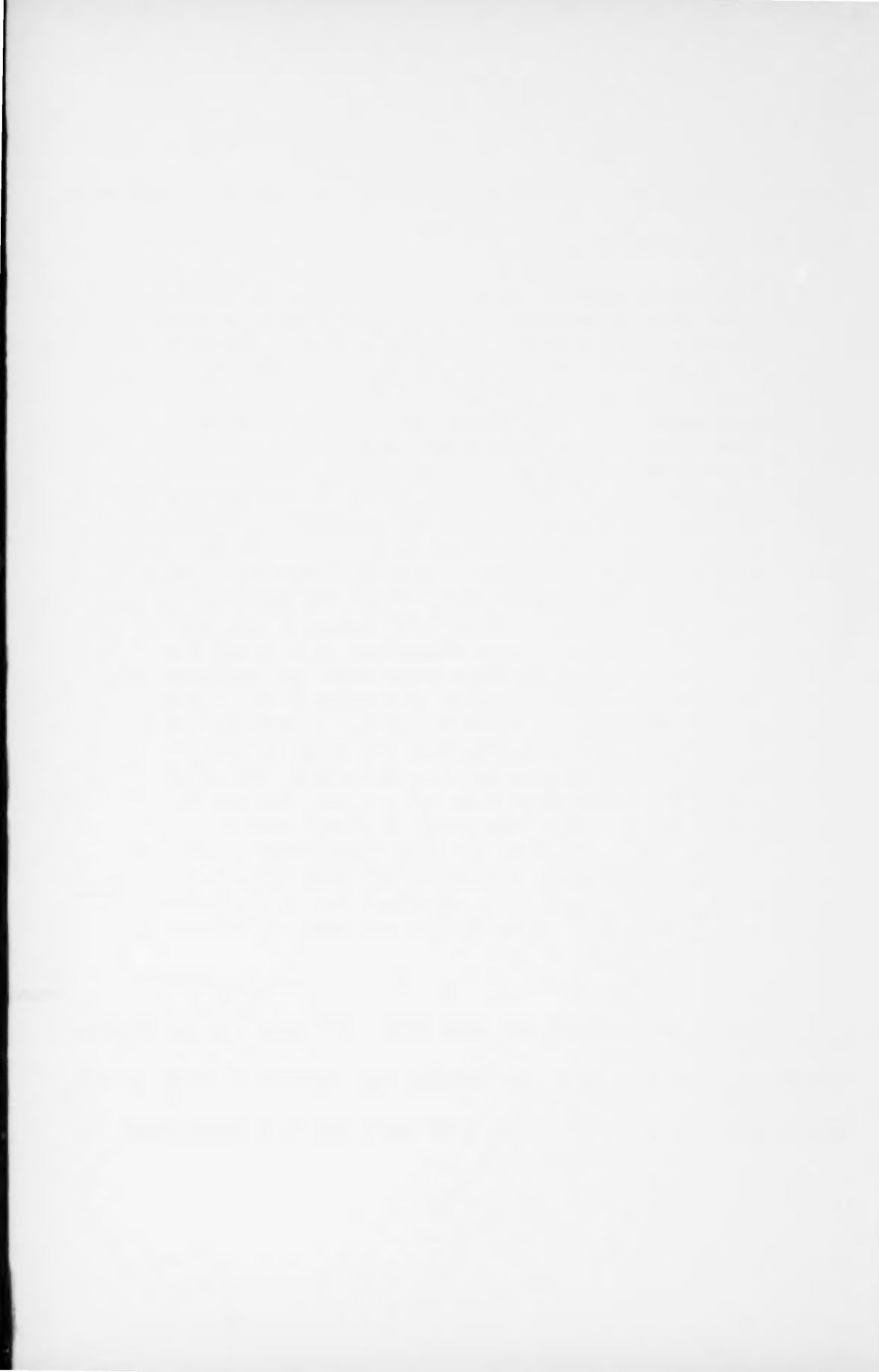
Moreover, the Court of Appeals appears to have lost sight of the purpose of the invention. In column one of the patent, the purpose of the



improvement of this invention is stated as follows (Appendix page 3):

Positive means is provided to effect proper placement of the appliance within the mouth. (Lines 30-32) Means are associated with the resilient appliance to effect proper mating engagement between the appliance and the teeth when the appliance is positioned within the mouth. (Patent column 1, lines 39-42). Positioning elements in the form of C-shaped clips are carried by the appliance for effecting temporary coupling between the appliance and the teeth by engagement in the embrasure areas of the teeth. (Patent, column 1, lines 46-49). Means are provided to assist and assure the proper placement of the appliance in the mouth, including C-shaped clips embedded in the rubber body and adapted to engage in the embrasure areas of the teeth. (Patent, column 1, lines 62-66). Means is provided on the appliance to assure proper seating of the teeth in the respective sockets in the appliance. (Patent, column 2, lines 1-3).

The remainder of the body of the tooth positioning appliance is made in accordance with expired Patent 2,531,222 and is not modified in



any way other than to include a C-shaped clasp (Appendix page 2, Fig. 7). Since the inventor testified and all parties agree that there were no modifications, either tried or adopted, that affected the showing in Figure 7 of the patent during the alleged experimentation, the only question that could have been the subject of experimentation is whether the device of Figure 7 that was tested achieved the stated objectives of the patent, as just quoted. It is important to note that all of the functions and objectives of the C-shaped clip related to positioning the appliance properly as it is placed in the mouth. The inventor himself testified that you could tell when the appliance was placed in the mouth, that those objectives were achieved.

The Court of Appeals for the Federal Circuit appeared to believe that what was being tested was the effectiveness of orthodontic treatment using



the appliance, but that had been established decades before when TP Laboratories began making and using the device of Patent 2,531,222 and others. That device was held to be unpatentable over the prior art in an earlier suit between the parties. TP Laboratories and its predecessor had been making such orthodontic appliances at least since 1953 under the guidance of Dr. Harold Kesling and it was not the subject of the experimentation at issue in this case.

Thus, the object of the experiments was simply to determine whether embedding a C-shaped clip in a known rubber orthodontic appliance would help it to go into place and stay in place. Once in place, it had been known for decades that it would do its job. It was also known that some patients cooperated better than others and got better results than others during orthodontic treatment and the specific outcome of specific



patient treatments was not the point of the experiment either. All of these things were thoroughly brought out in the testimony at the District Court level. The inventor, himself, testified that you could tell immediately with your hands as you placed the device whether the clip was going into place and holding. This is understandable since it had a tendency to snap into place as it passed the curve of the tooth. Even though the clip was substantially rigid, the tooth surface is curved and the resilient tension on the rubber body of the tooth positioner tends to pull the clip into the curve. In testifying about the appliance made for Nancy Furst, Dr. H. Kesling indicated that he knew right away that it was going into place.

Apparently, the Appellate Court was misled because it had not heard the entire trial and possibly overlooked the recitations (quoted above)



in the introduction to the patent in the suit, indicating that the appliance itself was old.

Against that background of facts established by agreement of the parties and by trial to the District Court, the Appellate Court used a somewhat different analysis that emphasized successful orthodontic treatment, although there was no testimony anywhere in the case that the success or failure of the orthodontic treatment as a whole depended on the claim of the patent in suit.

It was against that background that it evaluated the burden of proof and the burden of persuasion.

The Court of Appeals held, properly, that the burden of proof is on the defendant to prove prior public use under 35 U.S.C. § 102(b). Here the Exhibits, the testimony of the patients, and the testimony of the inventor himself established beyond a shadow of doubt that uses of the patented



invention took place in public. That brought the court directly to the Elizabeth v. Pavement, (supra) dilemma. Do we allow an exception to the statutory bar for public use earlier than allowed by the statute or do we allow the inventor to get by with such use on the ground that he should be afforded a reasonable opportunity for experiment? In Elizabeth v. Pavement, unlike the present case, it was essential that any experiment be public because the invention was a pavement. In the present case, it relates to a removable orthodontic appliance intended for use primarily at night but often recommended for a few hours during the day as well. It did not have to be worn continuously or in public places.

The District Court held on the undisputed evidence that there was no injunction of secrecy or silence imposed on the users. All of the orthodontists at Kesling and Rocke were asked whether



they imposed such conditions and each with the exception of Dr. Harold Kesling, said they did not. Dr. Harold Kesling said that he "thought" that they understood that there was a requirement for secrecy, but even when pressed, refused to testify that he had specifically told them that there was such a requirement. There were three depositions, two of patients, and in one case the father of a patient (Dr. Furst, Susan Spiers Elliot, and Sheila Rumely Brady). Dr. Furst was with his daughter Nancy when she received the tooth positioner with the clip of Figure 7 of the patent. The other two were themselves patients. None remembered being asked to keep the device in any way secret, confidential, or any other precaution having to do with disclosure. At least Susan Elliot testified that she deliberately showed it to her friends. There was definitely public, non-secret use.



3. The patent is invalid even if the burden of proof was on defendant as to experimental use.

Even if the burden of proof rested on defendant to prove the absence of experimental use in order to support the case of public use under § 102(b), that burden of proof was met as shown above. The analysis of the Court of Appeals for the Federal Circuit rested on facts not found by the District Court and on an analysis that missed the mark of the claimed invention of the patent without even specifically considering the fact that it was deviating from the finding of fact of the District Court. Defendant did meet its burden of proof. Defendant proved from the inventor's own lips that there were no experiments in fact.

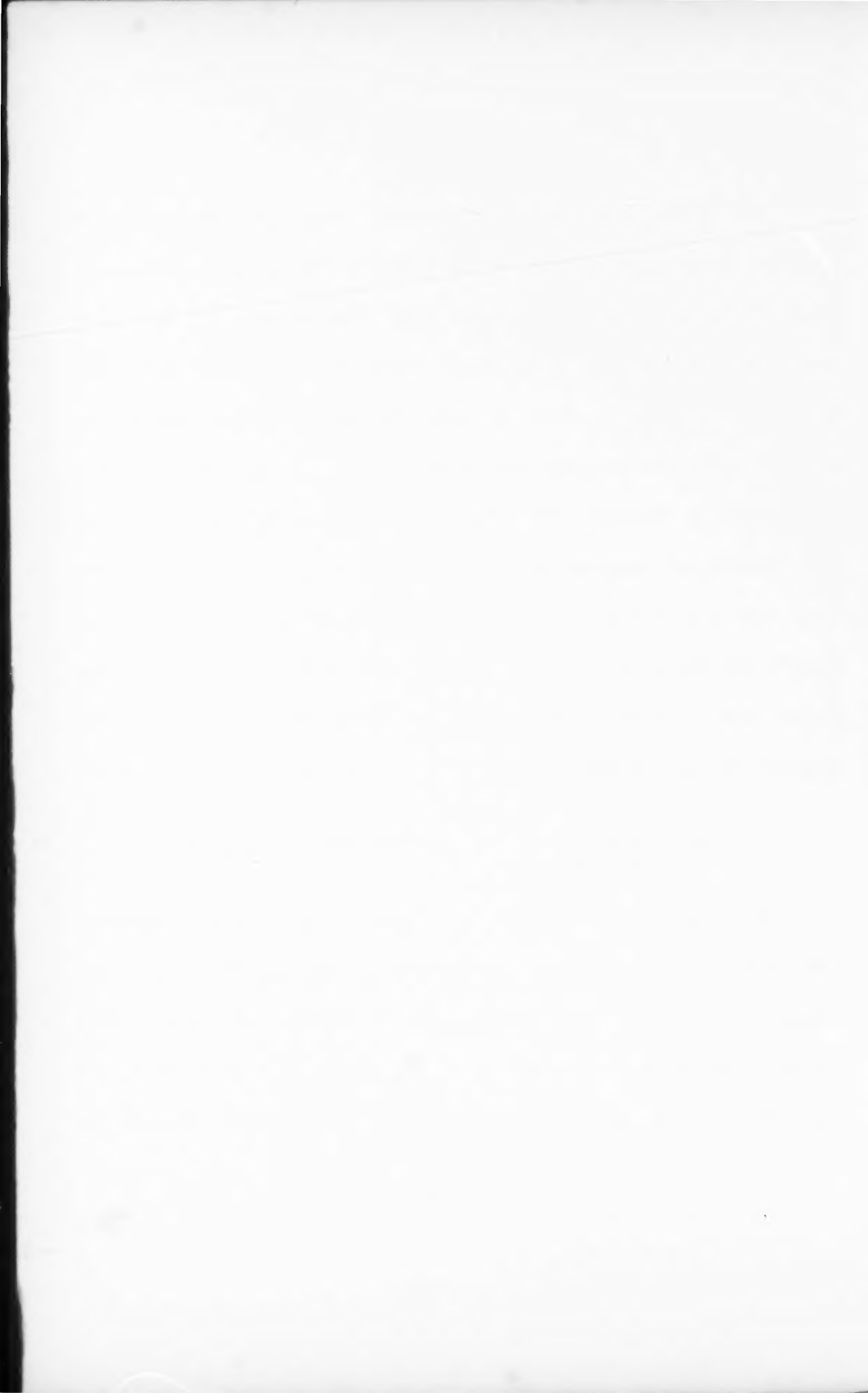
The District Court found on the basis of that testimony that there was no experiment in fact, at least after the treatment of Nancy Furst.



If the burden of proof was on defendant rather than plaintiff with regard to experimental use, the proper procedure for the Court of Appeals for the Federal Circuit was to remand to the District Court for a new determination based on all of the evidence in the case, including the witnesses heard by the District Court and not by the Court of Appeals. The Court of Appeals was not in an equally good position with the District Court to determine the facts and should not have done so. The case should have been remanded if changing the burden of proof affected the outcome.

4. The Court is requested to grant certiorari.

Petitioner submits that only the Supreme Court can restore the settled course of the law that properly requires the inventor to carry the burden of showing that 35 U.S. Code 102(b) should not bar his patent, once it has been shown by



clear and convincing evidence that a use or sale occurred more than a year before the filing of his patent application. Either the District Court decision should be restored or the case should be remanded to it for findings. Certiorari should be granted.

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